

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CME

Mailed: September 25, 2015

Cancellation No. 92061150

Fashion TV Programmgesellschaft mbH

v.

*Fashion Television International S.A.*¹

By the Trademark Trial and Appeal Board:

On May 4, 2015, Respondent filed a motion to dismiss Petitioner's petition for cancellation pursuant to Fed. R. Civ. P. 12(b)(6). Petitioner's response to the motion, filed May 20, 2015,² includes an amended petition for cancellation ("Amended Petition"). Petitioner's Amended Petition was filed within 21 days of Respondent's motion to dismiss, and therefore, was filed as a matter of course pursuant to Fed. R. Civ. P. 15(a)(1)(B). Accordingly, the Amended Petition is accepted and is now Petitioner's operative pleading in this proceeding. *See* Fed. R. Civ. P. 15(a)(1)(B); TBMP § 507.01 (2015). Because Respondent's motion to dismiss is based on the original petition for cancellation, which by this order has been superseded by the

¹ Office records show that Bigfoot Entertainment Inc. assigned all rights, title and interest in and to the involved mark to Fashion Television International S.A. on December 26, 2014. The assignment is recorded at Reel/Frame 5528/0013. Because the assignment occurred before institution of the proceeding, Fashion Television International S.A. is substituted as party defendant in this proceeding. *See* TBMP § 512.01 (2015).

² The Board treats May 20, 2015 as the filing date of Petitioner's response as this is the date that Petitioner filed an amended certificate of service to its filing. 8 TTABVUE.

Amended Petition, Respondent's motion is moot and will be given no further consideration. Respondent, however, maintains in its reply brief that the Amended Petition also fails to state a claim upon which relief can be granted. Accordingly, the Board construes Respondent's reply brief as a renewed motion to dismiss.³ Petitioner has not responded to the arguments in Respondent's renewed motion, but the Board considers Respondent's renewed motion on its merits. *See* Trademark Rule 2.127(a).

In considering whether the Amended Petition for cancellation sets forth a claim upon which relief can be granted, the Board has considered all of the arguments in Respondent's renewed motion, and presumes the parties' familiarity with the factual basis for Respondent's renewed motion, and does not recount the facts or arguments here, except as necessary to explain the decision.

A motion to dismiss under Rule 12(b)(6) is a test of the sufficiency of the complaint. To survive a motion to dismiss, a claimant need only allege sufficient factual matter as would, if proved, establish that (1) it has standing to maintain the claims, and (2) a valid ground exists for cancelling the mark. *See Lipton Indus., Inc.*

³ In support of its renewed motion, Respondent has submitted materials outside the pleadings. "Under Fed. R. Civ. P. 12(b)(6), if matters outside the pleadings are presented, and not excluded by the Board, the motion will normally be converted to one for summary judgment." *Nike, Inc. v. Palm Beach Crossfit Inc.*, ___ USPQ2d ___, Opp. No. 91218512 (TTAB Sept. 11, 2015). Here, Respondent's renewed motion to dismiss was filed before the parties' deadline to serve initial disclosures, and there is no indication that Respondent has served its initial disclosures. Accordingly, the Board will not consider Respondent's renewed motion as a motion for summary judgment. *See Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 (TTAB 2009) ("In *inter partes* proceedings commenced after November 1, 2007, a party may not file a motion for summary judgment under Trademark Rule 2.127(e)(1) until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Board.").

v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). “For purposes of determining the motion, all of the petitioner’s well-pleaded allegations must be accepted as true, and the [claims] must be construed in the light most favorable to petitioner. The pleading must be construed so as to do justice, as required by Fed. R. Civ. P. 8(e).” *Petroleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010).

Standing is a relatively low threshold requirement, intended only to ensure that the plaintiff has a real interest in the matter and is not a mere intermeddler. *See e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). To sufficiently allege standing within the meaning of Section 14 of the Trademark Act, 15 U.S.C. § 1064, a petitioner must plead facts sufficient to show that it has a direct and personal stake in the outcome of the cancellation proceeding and a reasonable basis for its belief that it will be damaged. *See Ritchie v. Simpson*, 50 USPQ2d at 1025-26. The focus must be on whether the petitioner has pleaded a reasonable basis for its belief in damage; there is no requirement that any actual “damage” be pleaded to establish standing or even to prevail in a cancellation proceeding.

As for whether a petitioner has sufficiently alleged a valid ground for cancellation, the complaint “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)).

In particular, a petitioner must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Id.* (citing *Twombly*, 550 U.S. at 555).

With respect to standing, Petitioner alleges in the Amended Petition that:

- Petitioner “broadcasts fashion-related content in the United States since at least 1998 and the [involved mark] is being actively used in attacks against Petitioner,” Amended Petition, preamble, ¶ 2;
- “Petitioner has been broadcasting its content, consisting primarily of fashion related programming, in the United States since at least 1998,” *Id.* ¶ 1;
- “Petitioner broadcasts its content on www.fashiontv.com, www.ftv.com as well as on YouTube and through the DISH Network.” *Id.* at ¶ 2;
- “[Respondent] claims an exclusive ‘brand’ interest emanating from the [involved mark] giving i[t] exclusivity in the mark FASHION TELEVISION which it is attempting to use towards eliminating Petitioner’s business. Specifically, Respondent has (i) filed an action attacking Petitioner’s domain name www.fashiontv.com claiming that it is confusingly similar to the [involved mark]; and (ii) caused cease-and-desist letters to be sent to Petitioner and its distributors alleging that Petitioner’s broadcasts are confusingly similar to the [involved mark], thus disrupting the marketplace and causing Petitioner to incur reputational damage.” *Id.* at Preamble, ¶ 2 and ¶¶ 12-13.
- “On or about December 5, 2014, Respondent sent cease-and-desist letters to Petitioner and its distributors demanding that Respondent terminate its broadcasts in the United States because they were confusingly similar to the [involved Mark].” *Id.* at ¶ 11.

The Board finds that these allegations are sufficient to plead that Petitioner is not a mere intermeddler and has a reasonable basis for its belief in damage.⁴ *See*

⁴ Respondent argues that the referenced “domain name proceeding was filed in Europe and is based solely on Community Trademark Registration No. 599829, not U.S. Registration

Miller v. Miller, 105 USPQ2d 1615 (TTAB 2013); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760-61 (TTAB 2013) (finding standing where respondent admitted that it was a competitor of petitioner and that it had sent a cease and desist letter to petitioner requesting that petitioner cease operation of its website and domain name), *aff'd*, 565 F. App'x. 900 (Fed. Cir. 2014) (mem.); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976-77 (TTAB 1988) (finding cease and desist letter coupled with plaintiff's use of mark sufficient to demonstrate opposer's standing); TBMP § 309.03(b); *Cf. Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 858-59 (TTAB 1986); *M. Aron Corp. v. Remington Prods., Inc.*, 222 USPQ 93, 96 (TTAB 1984).

The Board next turns to whether Petitioner has sufficiently pleaded a claim for abandonment. To adequately state a claim for abandonment, a plaintiff must allege facts that “set forth a prima facie case of abandonment by a pleading of at least three consecutive years of non-use or must set forth facts that show a period of non-use less than three years coupled with an intent not to resume use.” *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (internal citation omitted).

No. 2945497,” and in support thereof, attaches a copy of a purported World Intellectual Property Organization (“WIPO”) complaint. *See* Reply Brief, p. 5 and Exhibit B thereto. On a motion to dismiss, the Board may consider “matter of public record.” *Nike*, ___ USPQ2d at ___. The Board, however, cannot determine from Respondent's filing whether the WIPO complaint attached to its reply brief is a matter of public record. Accordingly, the Board has not considered this exhibit or Respondent's arguments related thereto.

In any event, Petitioner's allegations of use of the domain name www.fashiontv.com in connection with broadcasting fashion-related programming and that Respondent sent it a cease and desist letter are sufficient to plead Petitioner's standing. *See* cases cited *infra*.

Here, Petitioner has sufficiently set forth a prima facie case of abandonment by pleading nonuse of the involved mark since April 2012. Amended Petition, ¶¶ 15-17.⁵ The following allegations that use of the involved mark was discontinued with an intent not to resume use also are sufficient to set forth a claim for abandonment: (1) “Bell Media abandoned the [involved mark] with its final US use in April 2012,” *id.* at ¶ 15; (2) “Bell Media had no intent of resuming use when it ceased broadcast of programming utilizing the [involved mark] in April 2012,” *id.* at ¶ 18; (3) “As early as 2007, the owner of the [involved] Registration intended to abandon use of the [involved] mark outside Canada and accordingly began to unwind existing international licenses and syndication rights,” *id.* at ¶ 19; (4) “Since 2007 [Bell Media’s predecessor-in-interest] CTV had a general policy of not opposing proceedings in foreign jurisdictions, including the US, which sought cancellation of the registrations if the FT Fashion Television mark (which include the Mark central to this petition) were no longer in active use in those jurisdictions. [Bell Media’s legal counsel] notes that CTV made only the efforts needed to maintain foreign trademark registrations,” *id.* at ¶ 20; (5) “Bell Media followed CTV’s precedent policy of allowing cancellation proceedings brought in foreign jurisdictions where trademarks were no longer actively used to proceed unopposed and doing only the

⁵ Respondent’s argument that “[t]he very act of purchasing the rights to the [involved] mark in the United States for millions of dollars is clear evidence of an intent to resume use by the new owner and inherently refutes any *prima facie* showing of an intent to abandon the registered mark” concerns whether Petitioner can *prove* a claim of abandonment. Reply, p. 10. Such argument is premature because at the motion to dismiss stage the Board considers only whether the pleading sufficiently alleges a claim for relief that is plausible on its face. *See Twombly*, 550 U.S. at 570; *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case.”).

minimum required to maintain foreign trademark registrations,” *id.* at ¶ 21; and (6) “This policy of what amounted to cancellation upon request is clear, unequivocal evidence that the owner of the [involved mark] had no intention of resuming use of the Mark outside of Canada.” *Id.* at ¶ 22; *see also Parfums Nautee Ltd. v. Am. Int’l Indus.*, 22 USPQ2d 1306, 1310 (TTAB 1992) (“Abandonment of a registered mark cannot be *reversed* by subsequent re-adoption of a mark.”) (quoting *First Nat’l Bank of Omaha v. Autoteller Sys. Servs. Corp.*, 9 USPQ2d 1740, 1743 (TTAB 1988) (emphasis in original)).

In summary, Petitioner’s Amended Petition adequately sets forth Petitioner’s standing and a viable claim for abandonment. Accordingly, Respondent’s renewed motion to dismiss is **DENIED**.

The Board now considers Petitioner’s motion, filed June 9, 2015, to suspend this proceeding pending disposition of a civil action between Petitioner and Respondent’s predecessor-in-interest (*F.TV Ltd. and Fashion TV Programmgesellschaft MbH v. Bigfoot Entm’t, Inc.*, Case No. 1:14-cv-09856-KBF, pending in the U.S. District Court for the Southern District of New York) (the “Federal Case”). Respondent opposes the motion.

The Board’s well-settled policy is to suspend proceedings when one or both parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a). In both the Federal Case and this cancellation proceeding, Petitioner seeks to cancel Registration No. 2945407 on grounds of abandonment. Accordingly, the Federal Case “may have a bearing” on

this proceeding and proceeding here prior to termination of the Federal Case would be inefficient and pose a risk of inconsistent judgments.

In view of the foregoing, Petitioner's motion to suspend is **GRANTED** and proceedings are suspended pending final disposition of the Federal Case. Within **TWENTY DAYS** after the final determination of the Federal Case, the parties shall so notify the Board, including a copy of the court's final order, and call this case up for any appropriate action. During the suspension period, the Board shall be notified of any address changes for the parties or their attorneys.
